In the Drawings

There are no amendments to the drawings.

Remarks

The Examiner has rejected claims 1 – 9 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,341,803 to Koshida et al. ("the '803 patent"). The Examiner has further rejected claims 1 – 23 under 35 U.S.C. §103(a) as being unpatentable over U.S. Published Patent Application No. 2004/0166228 A1 to Loh et al. ("the '228 application") in view of U.S. Patent No. 6,312,745 to Durance et al. ("the '745 patent") and further in view of U.S. Patent No. 2,283,302 to Webb ("the '302 patent"). These rejections are respectfully traversed.

35 U.S.C. §102 (b) Rejections

The Examiner has stated that "absent a showing by clear and convincing evidence, it is not seen how the product claimed defines over the '803 patent. The prior art teaches a dried fruit product and therefore reads on the claimed invention" and that "patentability is based on the product itself." (Official Action pp. 2 – 3). Applicant agrees that patentability is based on the product itself. In this case, the claimed product of the present invention is different than that disclosed and taught in the '803 patent. The Examiner has stated that the '803 patent discloses a dried fruit product and that is what is presently claimed, however, this ignores all the limitations of the process for generating the dried food product as defined in Claim 1. The dried food product claimed in Claim 1 must be different than the dried food product disclosed in the '803 patent because they are created by different processes. In fact, the '803 patent itself asserts

that the process used to generate the end product is critical. For example, the '803 patent discloses that "[t]he drying treatment is necessarily performed in successive three stages, that is, freeze-drying, microwave irradiation under vacuum and vacuum-drying. The three drying stages should be in succession performed in the above-mentioned sequence and the elimination of one or two of the three drying stages *will not produce dry fruit chips having excellent touch or pleasantness to the teeth* to which the present invention is directed." (col. 4, lines 15 – 23)(emphasis added). Therefore, the '803 patent itself clearly states that if you don't specifically follow the steps disclosed therein, you will not achieve a dried food product according to the invention. In the present invention, the step of freeze-drying is specifically rejected. (*See*, para. 6 – 8).

The present claimed invention does not use the same process as disclosed in the '803 patent, but rather the process is as follows:

First step – (cleaned, pealed, seeded, shredded, and chopped into pieces)
Second step – (frozen)
Third step – (simultaneously thawed and predried)
Fourth step – (dried with hot air)
Fifth step – (microwave treatment)
Sixth step – (broken, sieved, selected, and packed)

Therefore, if the present claimed invention uses a different process, and the '803 patent clearly states if you don't follow the process disclosed therein you will not achieve a product according to the invention, the dried food product of Claim 1 must necessarily be different that the dried food product of the '803 patent.

The Examiner stated that product-by-process claims are limited by and defined by the process and that patentability is based on the product itself. (Official Action p. 3). In this case, Applicant respectfully submits that not only is the process of the present invention quite different, but the product generated by the process is different because the steps of freezing and drying are not simultaneously accomplished. (para. 6, 8 & 9). Rather, the drying process is performed at a later time where the benefit of the present invention is described "the simultaneous thawing predrying according to the invention, liquid oozing through broken cell membranes can be evaporated or ousted at once. Therefore produce product quality does not suffer from thawing, and a frozen product can be treated without the problems of pulpy states as mentioned above ever arising." (para. 10). Freeze-drying does not accomplish these advantages.

Accordingly, Applicant respectfully submits that because the claimed dried food product accordingly to Claim 1 does not use the same process as described in the '803 patent, and the '803 patent itself states that you will not achieve a product according to the invention of the '803 patent without following the precise steps outlined therein, the dried food product according to Claim 1 must be different than that disclosed in the '803 patent.

35 U.S.C. §103 (a) Rejections

It is well settled that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir.

1990). In this case Applicant respectfully submits that none of the cited references suggest the desirability of the combination suggested by the Examiner.

The dried food product of according to Claim 1 is different than that disclosed in the '228 application because Claim 1 requires "in a fifth treatment step, is subjected to a heat treatment in a vacuum by means of microwave treatment so that a cellular break-up and puffing up of said food occurs for obtaining well hydratable food being finally dried and having an instant character." (emphasis added). Claim 8 further requires among other limitations "heat treating by microwave treatment in a vacuum said food product so that a cellular break-up and puffing up of said food product occurs for obtaining hydratable food product being finally dried and hygienic." (emphasis added). Both of these steps are inapposite to the process taught in the '228 application. The '228 application teaches that "[a]pplication of the aqueous solution of the polyhydric alcohol prior to drying appears to allow sufficient migration of polyhydric alcohol into the cellular structure during drying, thereby effectively plasticizing the cellular structure of the fruits and vegetables. The resulting plasticized product is rendered non-brittle as indicated by a drastic reduction of lines and/or broken pieces." (para. 25).

It is also well settled that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In this case Applicant respectfully submits that while the '228 application teaches a process for avoiding cellular break-up, the Examiner has stated that the '745 patent teaches "microwave treatment so that a

cellular break-up and puffing up of the food occurs." (Official Action, p. 5). Applicant therefore respectfully submits that it cannot be obvious to combine the '228 application, which is directed to a method of avoiding cellular break-up with the '745 patent, which the Examiner submits teaches a method of cellular break-up as this works in contravention to and would defeat the purpose of the '228 application. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Accordingly, Applicant respectfully submits that because all the claims of the present application require microwave treatment so that a cellular break-up and puffing up of said food occurs and the '228 application is directed toward a method of avoiding such break-up, it cannot be obvious to modify the '228 application in view of the present claims. In addition, Applicant respectfully submits that because the '228 application is directed toward a method of avoiding cellular break-up, it cannot be obvious to combine the '228 application with the '745 patent as the Examiner has submitted.

It is respectfully submitted that claims 1 – 10 and 13 - 23, all of the claims remaining in the application, are in order for allowance and early notice to that effect is respectfully requested.

Respectfully submitted,

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